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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,311	06/12/2001	Kenji Okinaka	1417-352	2128

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EXAMINER

SHEEHAN, JOHN P

ART UNIT PAPER NUMBER

1742

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/878,311

Applicant(s)

OKINAKA ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-12 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group III, claims 9 to 12 and 16 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. The Examiner acknowledges applicants request to rejoin claim 15 once the elected product claims are in condition for allowance. Applicants are reminded that in order for process claims to be rejoined with allowed product claims the process claims must either depend from or otherwise include all the limitations of the allowable product claims, MPEP 821.04.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 to 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenji et al. (Kenji, cited in the IDS submitted February 25, 2002).

Kenji teaches spindle shaped magnetic metal particles having an average major axial diameter of 0.05 to 0.18  $\mu\text{m}$  (page 8, lines 19 and 20), an aspect ratio of from 4:1 to 9:1 (page 8, lines 22 and 23), a size distribution (standard deviation/average major axial diameter) of not more than 0.20 (page 8, lines 20 and 21), a crystallite size  $D_{110}$  of 13.0 to 17.0 nanometers (130 to 170  $\mu\text{m}$ ) (page 8, lines 34 and 35), a cobalt content of from 1 to 20 atomic percent, an aluminum content of from 1 to 15 atomic percent, a rare earth element content of from 1 to 15 atomic percent (page 8, paragraph 0082), a coercive force of from 1,800 to 2,500 Oe (143.2 to 198.9 A/m) (page 8, paragraph 0083) and an oxidation stability of saturation ( $\Delta\sigma_s$ ) of not more than 10% (page 8, paragraph 0085). Each of these powder characteristics and alloy proportions overlap the powder characteristic and proportions recited in the instant claims. Kenji teaches that the particles have a BET surface area of 40 to 60  $\text{m}^2/\text{g}$  (page 8, paragraph 0081), which is the same as the BET surface area recited in applicants claim 11. Kenji teaches that the disclosed metal particles are used in magnetic recording media (page 9, paragraph 0093) as recited in applicants' claim 16.

The claims and Kenji differ in that Kenji (1) does not teach the exact same powder characteristics and alloy proportions as recited in the instant claims; (2) Kenji is silent with respect to an atomic ratio of Al to Co; and (3) Kenji is silent with respect to the ignition temperature of the disclosed metal particles.

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However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the spindle shaped magnetic metal particles taught by Kenji overlap applicants' claimed alloy and therefore are considered to establish a prima facie case of obviousness, In re Peterson 65 USPQ2d 1379 (CAFC 2003, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05. Further, although Kenji does not teach an Al to Co ratio, the proportions of Al and Co taught by Kenji overlap applicants' claimed Al and Co proportions and thus encompass the Al to Co ratio recited in the instant claims. Regarding the ignition temperature, it is the Examiner's position that in view of the similarity in particle composition and the fact that all of the other properties of Kenji's particles and applicants' particles are the same or overlap, one of ordinary skill in that art would expect that Kenji's particles would have an ignition temperature that would at least overlap the ignition temperature recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP2112.01.


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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps  
July 24, 2003